

REMARKS

It is respectfully requested that the amendment adding claims 364-395 and cancelling claims 1-363 be entered.

The efflux pump inhibitors of claim 364 are described in the specification as follows:

Isopropyl 1-cyclopropyl-6-fluoro-8-methoxy-1,4-dihydro -7-(4'-amino-3',3'-dimethyl-piperidin-1-yl)-4-oxo-quinoline-3-carboxylate is compound number 3 on page 26, line 12-13 of the specification.

n-Butyl 1-cyclopropyl-6-fluoro-8-methoxy-1,4-dihydro -7-(4'-amino-3',3'-dimethyl-piperidin-1-yl)-4-oxo-quinoline-3-carboxylate is compound number 4 on page 26, lines 14-15.

Benzyl-1-cyclopropyl-6-fluoro-8-methoxy-1,4-dihydro -7-(4'-(t-butoxycarbonyl amino)-3',3'-dimethyl-piperidin-1-yl)-4-oxo-quinoline-3-carboxylate is compound 6 on page 26, line 18-19

(R)-(+)-Ethoxycarbonylmethyl-9-fluoro-6,7-dihydro-8-(4'-hydroxypiperidin-1'-yl)-5-methyl-1-oxo-1H,5H-benzo[i,j]quinolizine-2-carboxylate is compound 58 on page 21.

(S)-(-)-N-Methylpiperidin-1-yl-9-fluoro-6,7-dihydro-8-(4'-hydroxypiperidin-1'-yl)-5-methyl-1-oxo-1H,5H-benzo[i,j]quinolizine-2-carboxylate is compound 56 on page 21.

(S)-(-)-N-Morpholinoethyl-1-yl-9-fluoro-6,7-dihydro-8-(4'-hydroxypiperidin-1'-yl)-5-methyl-1-oxo-1H,5H-benzo[i,j]quinolizine-2-carboxylate is compound 57 on page 21.

(S)-(-)-9-Fluoro-6,7-dihydro-8-(4'-L-alaninyloxy-piperidin-1-yl)-5-methyl-1-oxo-1H,5H-benzo[i,j]quinolizine-2-carboxylic acid hydrochloride is compound 30 on page 24.

(S)-(-)-9-Fluoro-6,7-dihydro-8-(4'-D-leucyloxy-piperidin-1-yl)-5-methyl-1-oxo-1H,5H-benzo[i,j]quinolizine-2-carboxylic acid hydrochloride is compound 29 on page 24.

(RS)-(±)-9-Fluoro-6,7-dihydro-8-(4'-D-phenylalaninyloxy-piperidin-1-yl)-5-methyl-1-oxo-1H,5H-benzo[i,j]quinolizine-2-carboxylic acid hydrochloride is compound 26 on page 24.

All of these compounds were included in claim 328 filed with the previous response.

According to the Official Action claims 326, 329-332, 341-344, 346, 348 and 350-363 are rejected under 35 USC 102(b) as being anticipated by Grohe (US patent 4,563,459); and claims 326, 329-332, 341-344, 346, 348, and 350-363 are rejected as being anticipated by or in the alternative, under 35 USC 103(a) as being obvious over Ledoussal (US patent 6,329,39).

These rejections are respectfully traversed.

Neither of these references disclose the compounds of claim 364. Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *In re Paulsen*, 30 F.3d 1475, 31 USPQ 1671 (Fed. Cir. 1994). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991). Therefore, since each and every element of claim 364 is not disclosed in these patents, and claims 365-395 depend directly or indirectly from claim 364 these claims are not anticipated.

Therefore, it is respectfully requested that these rejections be withdrawn.

To establish prima facie, obviousness

- 1) the claimed invention must be considered as a whole;
- 2) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; and
- 3) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

Reasonable expectation of success is the standard with which obviousness is determined. *In re Merck & Co., Inc.*, 800 F.2d 109, 231 USPQ 375 (Fed. Cir. 1986).

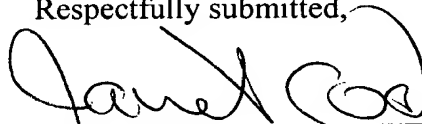
The reason, suggestion or motivation to combine references may be found explicitly or implicitly. While the references need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability must be clear and particular. *Ruiz v. A.B. Chance Co.*, 57 USPQ2d 1161 (Fed. Cir. 2000).

There is no disclosure or suggestion in Ledoussal to make or use the compounds of claim 364 and therefore, claim 364 and the claims dependent thereon are not obvious in view of Ledoussal.

As, claims 364-395 are not anticipated nor obvious over the reference and it is respectfully requested that the rejection be withdrawn.

Accordingly, it is submitted that claims 364-395 are patentable.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Janet I. Cord", written over a horizontal line.

Janet I. Cord
c/o Ladas & Parry LLP
26 West 61st Street
New York, NY 10023
Reg. No. 33,778 (212) 708-1935